

REMARKS

Claims 1, 18, 63, and 107-109 have been amended. No new matter has been added. In view of the foregoing amendments and the following remarks, Applicants respectfully submit that all pending claims are in condition for allowance.

Claim Rejections - 35 U.S.C. 103

Claims 1-13, 18-29, 63, and 107-109 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshimune et al. (U.S. Patent No. 6,438,233, hereinafter "Yoshimune") in view of Cassorla et al. (U.S. Patent No. 5,146,552, hereinafter "Cassorla"). Claims 14-17 and 30-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshimune in view of Cassorla and further in view of Kubota (U.S. Patent No. 5,506,902, hereinafter "Kubota"). Applicants traverse these rejections for at least the following reasons.

Independent claims 1, 18, 63, and 107-109 recite that the subscriber-created data associated with individual electronic books is stored directly in at least one field in a header file for each of the individual electronic books. The Examiner concedes that Yoshimune fails to disclose or teach subscriber-created data associated within individual electronic books being stored in a header file. However, the Examiner refers to col. 5, lines 31-50 of Cassorla and alleges that Cassorla discloses means for storing the subscriber-created data associated with individual electronic books in a header file for each of the individual electronic books. However, Cassorla does not disclose or

suggest that the subscriber-created data is stored directly in at least one field in a header file for each of the individual electronic books.

Cassorla discloses various types of annotations such as bookmarks, margin flags, and notes that can be created by readers of an electronic book (col. 4 to col. 5). Cassorla further discloses adding header information to each of the reader-created annotations or storing the information of annotation locations in the control header. However, Cassorla fails to teach or suggest storing the subscriber-created data associated with individual electronic books **directly in at least one field** in a header file for each of the individual electronic book. Therefore, even if the skilled artisan combines the disclosure of Yoshimune and Cassorla (alleged combination not admitted), the skilled artisan would not have arrived at the present invention.

For at least the above reasons, Appellants submit that independent claims 1, 18, 63, and 107-109 are not obvious over the combination of Yoshimune and Cassorla. Because claims 2-13 depend from claim 1 and claims 19-29 depend from claim 18, claims 2-13 and 19-29 are also not obvious over the combination of the cited references for at least the same reasons, as well as for the additional subject matter recited therein.

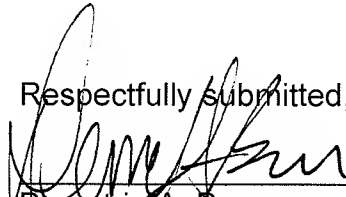
Conclusion

In view of the foregoing, Applicants respectfully request reconsideration of the application, withdrawal of the outstanding rejections, allowance of all pending claims, and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, referencing attorney docket number 033033-00013.

Respectfully submitted,



Demetria A. Buncum
Registration No. 58,848

Customer No. 004372
ARENT FOX LLP
1050 Connecticut Avenue, N.W., Suite 400
Washington, D.C. 20036-5339
Tel: (202) 857-6000
Fax: (202) 638-4810